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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,669	02/21/2001	Richard Oliver Kahn	30990156 US	6041

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EXAMINER
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VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/788,669	<b>Applicant(s)</b> KAHN ET AL.	
	<b>Examiner</b> John M. Villecco	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 8, 10 and 18-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.
2. Regarding the previous objection to claims 2, 8, and 10, applicant has amended claim 2 to overcome the previous objection. However claims 8 and 10 still make reference to deleting an image wherein the parent claim (claim 1) only states that the controller is only used to compress image files, not delete them. Additionally, applicant has added this limitation into claims 18-20. Therefore, claims 18-20 will be objected to also.
3. Regarding claim 1, applicant argues that claim 1 distinguishes over Torres by requiring the controller to select which information records to compress and how far to compress them on the basis of their priority rating (see page 16, lines 11-17 of the applicant's response). However, it is clear from col. 6, lines 13-32 of Torres that priority ratings are given to files and selects certain images to compress. Additionally, Torres discloses that certain files are not compressed and that certain files are compressed further from a JPEG format to a wavelet compression format. Thus the controller is adapted to select information records and how far to compress them based on a priority rating given to each file by the user. Applicant argues that Torres is deficient because it provides a predetermined level of compression. However, Torres discloses that images can be either compressed using wavelet compression or not compressed at all. Thus the controller does determine which files to compress and how far to compress them (wavelet compression or no compression) based on the priority ratings.

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4. As for claims 2 and 8, applicant argues that the combination of Torres and Imai is improper since Torres does not deal with deleting images. The examiner agrees with the applicant on this point. However, Torres is concerned conserving space in memory when it is determined that there is not enough memory to capture a new image. Imai, on the other hand, teaches that it is well known in the art to delete images based on a priority, if there is not enough memory to capture another image. Clearly, one of ordinary skill in the art at the time the invention was made would have been motivated, based on the teaching of Imai, to also delete images instead of compressing them in order to conserve more memory than would be conserved if the images were only compressed.

5. Applicant has amended claim 3, thus necessitating a new grounds of rejection. Please see the new grounds of rejection for claims 3-6 below.

6. As for claim 4, applicant argues that Makishima fails to disclose that a file to be stored initially at a lesser compression level such that the file can be recompressed one or more times up to the maximum level as the need arises. However, this limitation cannot be found in the language of claim 4. Thus, based on the language of claim 4, Makishima reads on the claimed invention.

7. With regard to claim 17, applicant argues that the examiner's assertion that "the CPU would have to do some type of calculating in order to associate the tag with the image" is without foundation. However, since Torres does disclose establishing a quality rating based on desired image quality, some type of calculating would have to take place to associate this priority tag with the image. One of ordinary skill in the art, would have found it inherent that the CPU (44) would indeed do some type of processing to associate the priority image tag with the image.

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8. With the exception of claims 4-6 and for the reasons stated above, the rejections from the previous office action will be repeated.

### *Claim Objections*

9. Claims 8, 10, and 18-20 are objected to because of the following informalities:

Regarding claims 8, 10, 19, and 20, are objected to because they still make reference to deleting an image wherein the parent claim (claim 1) only states that the controller is only used to compress image files, not delete them. Additionally, applicant has added this limitation into claims 19 and 20. Therefore, claims 19 and 20 will be objected to also.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1, 7, 13, 14, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Torres (U.S. Patent No. 6,564,282).**

12. Regarding *claim 1*, Torres discloses a method of increasing storage capacity in a digital image capture device. More specifically, Torres discloses an imaging device (114) which serves as the information record capture mechanism, a memory (354) which serves as the device

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memory, and a CPU (344) which serves as the controller. In a specific embodiment of the invention, when a user wishes to capture an image when the memory is full, a storage recovery operation takes place. The operation evaluates the compression level of previously saved image files and if they are not sufficiently compressed, further compresses the image files in order to create more space in the memory. See col. 5, line 55 to col. 6, line 12. Additionally, Torres discloses that the user has the ability to prioritize the images so that certain images are compressed before other images. See column 6, lines 13-31. Furthermore, Torres discloses that the system looks at the file extension to determine the level of compression. Therefore, by establishing a priority level the system is also determining how far to compress the image.

13. As for *claim 7*, Torres discloses that a use can establish a priority level based on whether or not certain images are archived (col. 6, lines 18-20). Therefore, the priority level can indicate whether an image is stored elsewhere.

14. With regard to *claim 13*, Torres discloses that an image can be marked so as not be compressed (col. 6, lines 23-25).

15. Regarding *claim 14*, Torres discloses that the designation may be given to an image by the user (col. 6, lines 17-18). Inherently, the buttons and dials (404) would be used to designate specific images.

16. As for *claim 25*, Torres discloses that an image can be compressed or not compressed. Therefore, the image is compressed by a variable amount.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282).**

19. Regarding claim 15, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that it is well known in the art to group similar images into categories. See column 5, lines 4-25. However, Torres fails to explicitly state that whole groups of information records may be given a common priority rating. However, one of ordinary skill in the art at the time the invention was made would have found it obvious to assign a specific priority to a group of tagged images so that a user would not have to select every image and give it a priority if a user would like to save every image in a specific category. This would save considerable time and effort in the operation of the camera.

20. **Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Imai et al. (Japanese Publ. No. 09-128276 A).**

21. Regarding *claim 2*, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. However, Torres fails to explicitly state that one option for compression is deleting the image data. Imai, on the other hand, discloses that it is well known in the art to delete prioritized image data if there is not even free memory to store new image

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data. In the abstract, Imai discloses a recording medium (3), wherein, if the free memory is not enough to store new image data, an erased file selection part (23) selects a file to be erased according to a priority. By deleting the image data instead of compressing it, more memory can be freed up. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the image data instead of compressing it so that more free memory is created.

22. As for *claim 8*, as mentioned above in the discussion of claim 7, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that images can be selected for compression if they are already archived (col. 6, lines 18-20). However, Torres fails to explicitly state that deletion of an image is only allowed if the image is stored elsewhere. Imai, on the other hand, discloses that it is well known in the art to delete prioritized image data if there is not even free memory to store new image data. In the abstract, Imai discloses a recording medium (3), wherein, if the free memory is not enough to store new image data, an erased file selection part (23) selects a file to be erased according to a priority. By deleting the image data instead of compressing it, more memory can be freed up. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the image data instead of compressing it so that more free memory is created.

23. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Sato (U.S. Patent No. 6,314,206).**

24. With regard to *claim 3*, as mentioned above in the discussion of claim 3, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that maintaining the



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quality of specific images may be important to a user. However, Torres fails to specifically disclose that the priority rating includes a maximum permissible compression level. Sato on the other hand discloses that a user can select a desired image quality and the system operates to set a maximum compression ratio. See column 5, line 57 to column 6, line 29. This allows a user to select a specific amount of compression in order to maintain a required image quality level. Therefore, one of ordinary skill in the art would have found it obvious to also include an image quality level in the priority rankings of the images so that a specific level of compression is achieved in order to maintain an image quality level.

25. **Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Sato (U.S. Patent No. 6,314,206) and further in view of Makishima et al. (U.S. Patent No. 6,549,307).**

26. Regarding *claim 4*, as mentioned above in the discussion of claim 3, both Torres and Sato disclose all of the limitations of the parent claim. Additionally, Sato discloses that the quality level is set by the user. However, neither of the aforementioned reference specifically discloses that the compression levels are set for defined functional purposes. Makishima, on the other hand, discloses that based upon whether an image is to be printed or displayed a compression level is set. See column 2, lines 31-46. Therefore, the amount of compression can be set based upon the situation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the compression level to be suitable for defined functional purposes so that optimal image reproduction can take place.

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27. As for *claim 5*, Makishima discloses that a user can select a printing mode in which an optimal compression is selected (col. 5, lines 8-60).

28. With regard to *claim 6*, Makishima discloses that a displaying method can be selecting in which an optimal compression rate is selected.

29. **Claims 9, 16, 17, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431).**

30. Regarding *claim 9*, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. However, neither of the aforementioned references discloses an interface for downloading information records from a remote source. Oie, on the other hand, discloses that it is well known in the art to download images onto a camera from a remote source. More specifically, Oie discloses a camera (1a) which uses a communication terminal (47) to communicate with camera (1b). The camera (1a) sends selected images to camera (1b). By sending images from one location to a camera, the user of the camera is capable of viewing images taken by another user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download information from a remote source so that one can view images taken remotely.

31. As for *claim 16*, Torres discloses a method of increasing storage capacity in a digital image capture device. More specifically, Torres discloses an imaging device (114) which serves as the information record capture mechanism, a memory (354) which serves as the device memory, and a CPU (344) which serves as the controller. In a specific embodiment of the invention, when a user wishes to capture an image when the memory is full, a storage recovery

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operation takes place. The operation evaluates the compression level of previously saved image files and if they are not sufficiently compressed, further compresses the image files in order to create more space in the memory. See col. 5, line 55 to col. 6, line 12. Additionally, Torres discloses that the user has the ability to prioritize the images so that certain images are compressed before other images. See column 6, lines 13-31. Furthermore, Torres discloses that the system looks at the file extension to determine the level of compression. Therefore, by establishing a priority level the system is also determining how far to compress the image.

Torres, however, fails to specifically disclose that the device includes a communications link for receiving information record captured at a remote information capture device. Oie, on the other hand, discloses that it is well known in the art to download images onto a camera from a remote source. More specifically, Oie discloses a camera (1a) which uses a communication terminal (47) to communicate with camera (1b). The camera (1a) sends selected images to camera (1b). By sending images from one location to a camera, the user of the camera is capable of viewing images taken by another user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download information from a remote source so that one can view images taken remotely.

32. As for *claim 17*, Torres discloses that the user is able to set a priority rating based upon whether or not the image quality is important. See column 6, lines 15-30. The predetermined criteria is the image quality. Furthermore, the CPU (344) would have to do some type of calculation in order to associate the tag with the image.

33. As for *claim 26*, Torres discloses that an image can be compressed or not compressed. Therefore, the image is compressed by a variable amount.

34. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431) and further in view of Sato (U.S. Patent No. 6,314,206).**

35. With regard to *claim 3*, as mentioned above in the discussion of claim 3, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that maintaining the quality of specific images may be important to a user. However, Torres fails to specifically disclose that the priority rating includes a maximum permissible compression level. Sato on the other hand discloses that a user can select a desired image quality and the system operates to set a maximum compression ratio. See column 5, line 57 to column 6, line 29. This allows a user to select a specific amount of compression in order to maintain a required image quality level. Therefore, one of ordinary skill in the art would have found it obvious to also include an image quality level in the priority rankings of the images so that a specific level of compression is achieved in order to maintain an image quality level.

36. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431) and further in view of Sato (U.S. Patent No. 6,314,206) and Makishima et al. (U.S. Patent No. 6,549,307).**

37. Regarding claim 12, as mentioned above in the discussion of claim 11, Torres, Oie, and Sato disclose all of the limitations of the parent claim. Additionally, Sato discloses that the quality level is set by the user. However, neither of the aforementioned reference specifically discloses that the compression levels are set for defined functional purposes. Makishima, on the

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other hand, discloses that based upon whether an image is to be printed or displayed a compression level is set. See column 2, lines 31-46. Therefore, the amount of compression can be set based upon the situation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the compression level to be suitable for defined functional purposes so that optimal image reproduction can take place.

***Allowable Subject Matter***

38. Claims 10, 18, and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

39. Regarding claims 21 and 23, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the priority is based on expected use of the information record.

40. As for claims 10 and 18, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that deletion of an information record by the controller is only permissible if the information record is a downloaded information record.

However, please note the objection to the claims as previously presented.

41. Additionally, claims 19 and 20 include allowable subject matter similar to claims 10 and 18. However, please note the objection to the claims as previously presented.

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42. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

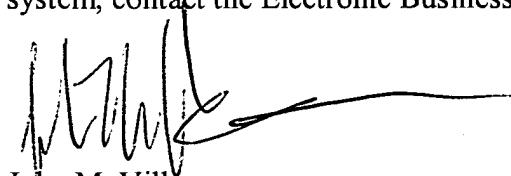
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460 (Crystal City) or (571) 272-7319 (Carlyle). The examiner can normally be reached on Monday-Thursday.

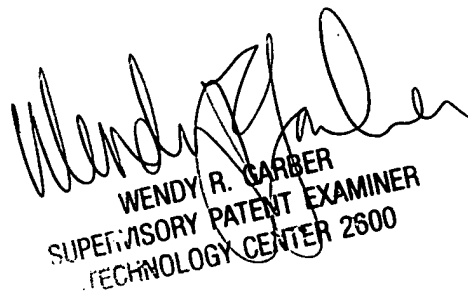
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929 (Crystal City) or (571) 272-7308 (Carlyle). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco  
February 10, 2005



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